



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,178	07/16/2003	Douglas S. Horne	8603.63	2354

21999 7590 02/28/2007
KIRTON AND MCCONKIE
60 EAST SOUTH TEMPLE,
SUITE 1800
SALT LAKE CITY, UT 84111

EXAMINER

ROGERS, KRISTIN D

ART UNIT	PAPER NUMBER
----------	--------------

3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/621,178

Applicant(s)

HORNE ET AL.

Examiner

Kristin D. Rogers

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1,6, and 15 are rejected under 35 U.S.C. 10a(a) as being unpatentable over Lum et al. (6391005) in view of Rentea (20030055357). In regard to claims 1 and

Art Unit: 3736

15, Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe 150 for measuring an electrical signal at a patient's skin (column 3, lines 35-45 and column 5, lines 36-51), contacting with stationary element isolation hood of probe 180 the patient's skin, actuating motor 158 and feedback loop 104, which senses the pressure applied by the probe tip, applying pressure to the tip of probe 150 independent from pressure of the stationary hood 180 and measuring the electrical attribute of the location on the skin in the form of an impedance (Figure 1 and 7b). In regard to claim 6, Lum et al. shows a method of stabilizing a probe against the dermal area, measuring an electrical signal value and comparing the signal value to the pressure applied and changing the future amount of pressure when a different previous electrical signal value varies from the present electrical signal value (column 6 line 50 to column 7 line 5. Claims 19-20 teach the claimed method). Lum et al. is silent regarding the point of measuring at the skin being a meridian. Rentea teaches a method for obtaining an electrical signal from a patient at the patient's skin comprising contacting the patient's skin with a probe 100 and measuring an electrical attribute corresponding to a meridian (paragraph 15). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lum et al. with a method of measuring the electrical attribute at a point defining a meridian or acupuncture point as taught by Rentea since such modification would provide a means for measuring electrical signals on the skin of a patient.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. and Rentea in view of Anderson (3784908). Lum et al. shows a method of obtaining an

Art Unit: 3736

electrical signal from a patient including locating a probe, but lacks a point locator providing audible signals. Anderson teaches a method of electrical conductivity in which the dermal area of a patient is located with point locator 35 whereby the point locator 35 indicates the area of highest electrical conductivity. The point locator produces audible signals that can be observed via earphones 45 (column 5, lines 21-26). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a point locator producing audible signals as taught by Anderson for the purpose of providing an audible indication of the dermal area with substantial electrical signal.

6. Claims 3-4, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. and Rentea in view of Lum et al. (Figure 7B). Lum et al. shows a method of obtaining an electrical signal from a patient including locating a dermal area on a patient and contacting the area with a probe tip 150 and stationary element 152, detector 120, feedback loop 104 that provide electrical signal information, but is silent regarding the point of measuring at the skin being a meridian and lacks a biasing element and control of the biasing element providing electrical signals from the feedback loop. In regard to claims 3-4, 7 and 11, Rentea teaches a method for obtaining an electrical signal from a patient at the patient's skin comprising contacting the patient's skin with a probe 100 and measuring an electrical attribute corresponding to a meridian (paragraph 15). Lum et al. (Figure 7B) teaches a stationary hood 180 a biasing element comprising spring 176A and 176B connected to the probe and probe tip 150 for controlling the pressure applied to probe tip 150 from actuating the biasing

element (column 5, lines 36-50 and column 3, lines 15-27, 65-67 to column 4, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a method of measuring the electrical attribute at a point defining a meridian or acupuncture point as taught by Rentea since such modification would provide a means for measuring electrical signals on the skin of a patient and with a biasing element controlled by feedback loop as taught by Lum et al. (Figure 7B) since such modification would provide a means for controlling the amount of pressure applied to probe tip and receiving electrical signal information.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al. and Rentea in view of Teller et al. (20040133081). Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe, but lacks a convex probe tip. Teller et al. teaches a method of using an apparatus for detecting bioimpedance comprising a convex probe 805 comprising an abrasive bristly matrix 830 (page 20 paragraph 157 and page 25 paragraph 187 Figure 23). Therefore it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Lum et al. with a convex probe tip with a bristly matrix as taught by Teller et al. for the purpose of providing a abrasive surface contacting the dermal area of a patient.

8. Claims 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al., Rentea, and Lum et al. (Figure 7) as applied to claims 7 and 11 above, and further in view of Anderson. Lum et al. shows a method of locating a dermal area, but lacks a point locator providing audible signals. Anderson teaches a method of measuring electrical conductivity (conductance) in which the dermal area of a patient is

Art Unit: 3736

located with point locator 35 whereby the point locator 35 indicates the area of highest electrical conductivity. The point locator produces audible signals that can be observed via earphones 45 (column 5, lines 21-26). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lum et al. with a point locator producing audible signals as taught by Anderson for the purpose of providing an audible indication of the dermal area with substantial electrical signal given as a conductance value.

9. Claims 9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lum et al., Rentea, and Lum et al. (Figure 7) and Anderson, as applied to claims 8 and 12 above, and further in view of Teller et al. Lum et al. shows a method of obtaining an electrical signal from a patient including locating a probe, but lacks a convex probe tip. Teller et al. teaches a method of using an apparatus for detecting bioimpedance comprising a convex probe 805 comprising an abrasive bristly matrix 830 (page 20 paragraph 157 and page 25 paragraph 187 Figure 23). Therefore it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Lum et al. with a convex probe tip with a bristly matrix as taught by Teller et al. for the purpose of providing a abrasive surface contacting the dermal area of a patient.

Response to Arguments

10. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Rogers whose telephone number is 571.272.7293. The examiner can normally be reached on Monday through Friday 8:00am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


KDR

